35 U.S.C. § 112, second paragraph rejections

It is believed that the amendments made to the claims address the examiners rejections based on 112, second paragraph. If not, it is requested that the examiner point out language that she would find acceptable (see MPEP 707.07(j)).

35 U.S.C. § 103 rejection

Claims 1-11 were rejected by the examiner as being obvious over Msika et al. in view of Nakane et al. The examiner asserts that Msika et al. teaches "meets" every element of the applicants claims except for exemplification of stick forms. The applicants request reconsideration for the following reasons. (Question: What is the examiner's standard that the Msika et al. reference "met" the claims recited by the applicants? If Msika et al. truly "met" the applicants claims Msika et al. would be a 102(b) reference for claims 1-7 and 9-11. This is analogous to *In re Ruschig*, 145 USPQ 275, (CCPA 1965): "To say that prior art compounds are 'within the scope of' rejected claims is to say that claims are 'anticipated'.".)

First, when considering the teachings of Msika et al. as a whole, it is clear that their invention is directed toward sunscreen compositions (which can be water-in-oil type emulsions) which contains not only a specific amount of titanium oxide and zinc oxide particles but a ***synergic amount*** and is designed to have a specific wetting point and flow point for the titanium dioxide and zinc oxide which differs from the applicants emulsion which contains a phyllosilicate pigment particle and a fat or wax which melts at a temperature above 40°C in the oil phase.

The extent that the various conditions, as claimed by the applicants, are "met", as presumed by the examiner, ignores the salient features of the Msika et al. teachings. However, it is well known that while a prior art reference can be used for what it teaches and not just the claimed invention, MPEP 2141.02 makes the contingency that "***A prior art reference must be considered in its entirety***, i.e. as a **whole**, ***including portions that would lead away from the claimed invention.***"[1] It has also been held that ***"[i]t is impermissible*** within the framework of section 103 ***to pick and choose*** from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art."[2]

[1] see MPEP 2141.02 and *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983)

[2] see *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965)

Only newly added claim 13 mentions titanium oxide and zinc oxide in the same breadth and even then it is not required that both are present in the preparation much less in "synergic amounts" or with specific wetting and flow points.

Moreover, to establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. see MPEP 2143.03 and *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The applicants claims may or may not have titanium oxide/zinc oxide whereas in Msika et al. this is a primary feature of their invention. There would be no motivation by one of ordinary skill in the art to remove this feature from Msika et al. and ensure the presence of a phyllosilicate in order to arrive at the applicants claimed invention.

Additionally, the fatty and/or waxy components of the applicants claims must have a melting point of above 40°C which is not taught or suggested by the Msika et al. reference.

Nakane et al. does not remedy the deficiencies of the Msika et al. reference as this reference only teaches that phyllosilicates are used in stick forms but does not provide the motivation to one of ordinary skill in the art to modify the teachings of Msika et al. to arrive at the applicants' invention. MPEP 2143.01 states that "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." see also *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430, (Fed. Cir. 1990). The motivation statement written in the office action appears to be have come from the examiner and not from any direction from the references themselves.

Closing

Applicants believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Hon. Commissioner of Patents, Washington, D.C. 20231, on the date indicated below:

Date: **14 September 2001** By _____
Howard C. Lee

CLEAN COPY OF CLAIMS SHOWING AMENDMENTS

1. Cosmetic or dermatological stick preparations, which are finely disperse ***water-in-oil*** systems **[of the water-in-oil type]**, comprising

   a) an oil phase which comprises from 10 to 70% by weight, based on the weight of the **[fatty phase]** ***oil phase***, of fatty and/or wax components which melt above a temperature of 40°C,

   b) a water phase,

   c) at least one modified phyllosilicate ***pigment particles*** which exhibits both hydrophilic and lipophilic properties, which thus has amphiphilic character and positions itself at the water/oil interface, and

   d) at most 0.5% by weight***, based on the total weight of the preparations,*** of one or more emulsifiers.

2. Preparation according to Claim 1, characterized in that it is emulsifier-free.

3. Preparation according to Claim 1 or 2, characterized in that the water phase content is chosen from the range from 15 to 60% by weight, based on the total weight of the preparations.

4. Preparation according to **[one of the preceding claims]** ***claim 1***, characterized in that further cosmetic or pharmaceutical auxiliaries, additives and/or active ingredients are present.

5. Preparation according to **[one of the preceding claims]** ***claim 1 or 4***, characterized in that the content of modified phyllosilicate ***pigment*** particles used is between 0.1% by weight and 30% by weight, based on the total weight of the preparations.

6. Preparation according to **[one of the preceding claims]** ***claim 1 or 4***, characterized in that the modified phyllosilicate**[(s)]** ***pigment particle(s)*** is/are chosen from the group which includes modified smectites, modified bentonites, modified montmorillonites and modified hectorites**[, in particular from the group consisting of stearalkonium hectorite and quaternium-18 hectorite]**.

7. Preparation according to **[one of the preceding claims]** ***claim 1 or 4***, characterized in that, in

addition to one or more modified phyllosilicate**[s]** ***pigment particle(s)***, **[further pigments are present, in particular]** ***(a) further pigment(s) are present which are selected from the group consisting of*** modified polysaccharides **[and/or]** , microfine polymer particles **[and/or]** , boron nitride and**[/or]** micronized, inorganic pigments **[which are chosen from the group of amphiphilic metal oxides, in particular from the group consisting of titanium dioxide, zinc oxide, iron oxides or iron mixed oxides, silicon dioxide or silicates,]** where the pigments can be present either individually or in a mixture.

8. Preparation according to **[one of the preceding claims]** ***claim 1 or 4***, characterized in that it is in the form of a make-up and/or cosmetic stick, and additionally comprises at least one dye and/or one **[colour]** color pigment.

9. Preparation according to **[one of the preceding claims]** ***claim 1 or 4***, characterized in that it comprises one or more additives or active ingredients ***selected*** from the group **[of astringents and/or antioxidants and/or UV filter substances and/or antimicrobial substances and/or substances which are effective against acne.]** ***consisting of astringents, antioxidants, UV filter substances, antimicrobial substances and substances effective against acne.***

10. Method for the preparation of Pickering emulsion sticks, characterized in that modified phyllosilicate ***pigment*** particles are dispersed **[in a manner known per se]** in the **[fatty]** ***oil*** phase, which comprises from 10 to 70% by weight, based on the weight of the **[fatty]** ***oil*** phase, of fatty and/or wax components which melt above a temperature of 40°C, and, **[if desired]** ***optionally***, cosmetic or pharmaceutical auxiliaries, additives and/or active ingredients, with uniform stirring and optionally with heating, and, during the **[homogenization operation]** ***uniform stirring***, the water phase, which, **[if desired, likewise]** ***optionally*** comprises cosmetic or pharmaceutical auxiliaries, additives and/or active ingredients, is mixed with the **[fatty]** ***oil*** phase.

11. Preparation according to claim 6, characterized in that the modified phyllosilicate pigment particle(s) is/are a modified hectorite selected from the group consisting of stearalkonium hectorite and quaternium-18 hectorite.

12. Preparation according to claim 7, wherein the micronized, inorganic pigments is/are an

amphiphilic metal oxide(s).

13. Preparation according to claim 12, wherein the amphiphilic metal oxide(s) are selected from the group consisting of titanium dioxide, zinc oxide, iron oxides or iron mixed oxides, silicon dioxide or silicates.

14. Preparation according to claim 8, characterized in that the make-up and/or cosmetic stick form is selected from the group consisting of eyebrow pencil, kohl pencil, eyeshadow pencil, eyeliner pencil, concealer stick, powder stick, decorative stick and care lipstick.